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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/611,411 | 06/30/2003 | Scott Manzo | 017516-009700US | 2194 |

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PATENT DEPT
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EXAMINER

VRETTAKOS, PETER J

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3739

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 01/09/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/611,411

Applicant(s)

MANZO ET AL.

Examiner

Peter J. Vrettakos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2006.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 49 and 50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 49-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-19 and 49-50 are pending. All other claims cancelled.

The action is final.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 and 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgmeier et al. (6,090,107) in view of Weaver et al. (5,496,315).

(All parentheticals refer to Borgmeier et al. unless stated otherwise.)

The prior art discloses an end effector device (see figure 4) and method of manufacturing comprising:

- an RF (col. 4:1-4) electrode (56) probe;
- a removable and mechanical coupling mechanism (threading 44, 66; inherently disposable);
- an insulative sleeve (61) around an insulation layer (60);
- a sealing ring (Weaver et al.; o-ring 19); and
- an insulation layer (60) around the electrode (56) and the o-ring (obvious; Weaver et al.; o-ring 19).

Borgmeier et al. discloses the desire for a tight fluid seal (with element 61) to prevent accumulation of contaminants in col. 2:48-51 and col. 7:49-52. Borgmeier et al. is silent, however, regarding a sealing ring (o-ring).

Weaver et al. in an analogous electrosurgical device discloses an insulative sleeve with an o-ring to prevent accumulation of contaminants (col. 1:35-43).

Regarding claims 17-18, plastic materials in the sleeve (61) and layer (60) are found in Borgmeier et al. col 5:4-11.

Obvious design choices in claims 7-11, 14-15, 51, 52
(spring tabs, latching members, gripping members, electrical tabs, two sealing rings)

Notwithstanding most of the above elements are different species with different figures, the elements are obvious design modifications. The Applicant in the Specification shows no criticality or unexpected result associated with the elements.

With regards to a proximal sealing ring (claims 51, 52), it would be obvious to place at the proximal end of element 61 in figure 5 of Borgmeier et al. an o-ring (Weaver et al. 19). This is especially true because Borgmeier discloses the benefits of the sealing effect (col. 2:48-51 and col. 7:49-52) of the entire element 61 and not just its distal tip. This sealing effect would be potentiated through the proximal placement in element 61 the o-ring (19) disclosed in Weaver et al.

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Borgmeier et al. in view of Weaver et al. by including in the Borgmeier et al. electrosurgical device an o-ring as seen in the Weaver et al. electrosurgical device the motivation being to potentiate the advantageous sealing effect of Borgmeier et al. element 61.

Response to Arguments

Applicant's arguments filed 8-22-06 have been fully considered but they are not persuasive.

Prior 35 USC § 112 rejections are obviated through amendment ("surface" insertion into claims).

The Applicant argues that Borgmeier 6,090,107 is not rigid and that neither Borgmeier nor Weaver 5,496,315 discloses two sealing rings. In response to the first argument the Office asserts that Borgmeier element 61 is merely suggested in the patent to be flexible. The patent reads,

"[w]hile overboot 61 is described and illustrated as being a generally tubular, flexible and resilient elastomer, it will be readily apparent to those skilled in the art that **any number of alternative embodiments and structures could be employed to perform the same or equivalent functions**. Accordingly, **any suitable material** and structure known in the art that **performs the same or equivalent functions of sealing and electrically insulating** the coupling means is contemplated within the meaning of the term sealing and insulating means."

The Office asserts that "any suitable material" could very easily and obviously be a "rigid" elastomer thereby making obvious the Applicant's rigid sleeve. Further along

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the same lines, flexible versus rigid in this context is merely an obvious engineering/design choice. The difference between Applicant's rigid sleeve is not sufficient by itself to patentably distinguish over an otherwise old device (Borgmeier element 61) unless there are new or unexpected results. Therefore, the argument/amendment is not persuasive.

The Office also asserts that Weaver discloses one sealing ring; however, see MPEP § 2144.04 VI B. regarding obviousness and duplication of parts:

B. Duplication of Parts

In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) (Claims at issue were directed to a water-tight masonry structure wherein a water seal of flexible material fills the joints which form between adjacent pours of concrete. The claimed water seal has a "web" which lies ** in the joint, and a plurality of "ribs" ** >projecting outwardly from each side of the web into one of the adjacent concrete slabs. <The prior art disclosed a flexible water stop for preventing passage of water between masses of concrete in the shape of a plus sign (+). Although the reference did not disclose a plurality of ribs, **the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.**)

To this end, the argument that two sealing rings is patentable over one (as in Weaver) is not persuasive.

The Applicant also argues that the Weaver sealing ring "may not work" in Borgmeier. Not only is this statement not confirmable, it is believed to be irrelevant as being to the effectiveness of the combination of patents. Also, any "leakage" as a result of combining Weaver and Borgmeier might be resolved through simple routine experimentation.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

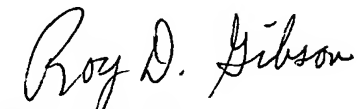
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pete Vrettakos
December 29, 2006




ROY D. GIBSON
PRIMARY EXAMINER